JUL 22 1941
CHARLES ELMORE CROPLEY

IN THE

# Supreme Court of the United States

No. 298.

FRED I. GETTY, *Petitioner*,

v.

KINZBACH TOOL COMPANY, INC., ET AL., *Respondents*.

## PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE FIFTH CIRCUIT.

NELSON J. JEWETT,
J. O. MODISETTE,
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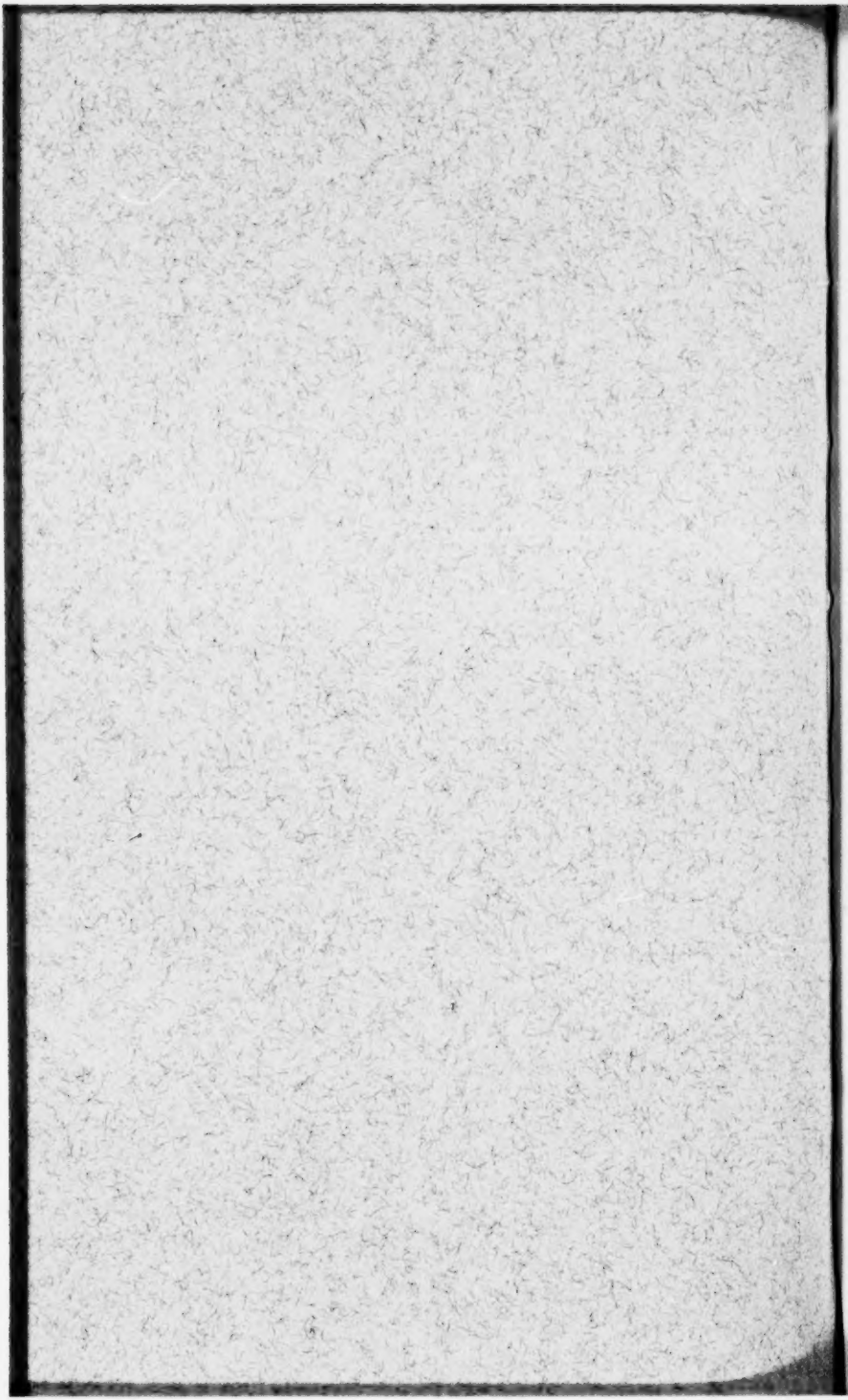

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## PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE FIFTH CIRCUIT.

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*To the Honorable the Chief Justice and the Associate Justices of the Supreme Court of the United States:*

FRED I. GETTY, of Jennings, Louisiana, prays that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the Fifth Circuit entered in the above case at New Orleans, Louisiana, on April 22, 1941, which affirmed the judgment entered in the District Court of the United States for the Southern District of Texas on the 18th day of April 1940, holding claims 3, 4, 5, 7 and 8 of patent No. 1,502,428 issued to Fred I. Getty, petitioner, on July 22, 1924, for Whipstock for Oil Wells, valid but not infringed.

## OPINIONS BELOW.

The opinion rendered in the District Court held that the presumption of validity resulting from the grant of the patent had not been overcome, that the claims were not infringed, and that it was unnecessary to determine the question of laches arising through delay in bringing suit.

The opinion rendered in the Circuit Court held that the question of validity was not before the Court, that the claims are relatively very broad; that the elements of the combinations claimed which are monopolized by the claims are only those disclosed; and that since a certain element of the structure complained of, performed a function in addition to the functions performed by its prototype in the structure shown and described for purposes of illustration in the patent, therefore it was not a mechanical equivalent and the claims were therefore not infringed. Petition for reconsideration was denied.

The opinion of the District Court is not reported.

The opinion of the Circuit Court of Appeals, reported 119 F. (2d) p. 249, will be found in the record at page 583.

## JURISDICTION.

Jurisdiction is invoked under the provisions found in the Act of March 3, 1911, Sec. 24 (U. S. C. title 28, sec. 41); Sec. 128 (U. S. C. title 28, sec. 225); Sec. 240 (U. S. C. title 28, sec 347).

## QUESTIONS FOR DETERMINATION.

(1) Is the coverage of valid, very broad combination claims of a pioneer patent limited to the exact forms of elements disclosed for purposes of illustration?

(2) Where an element of the structure complained of performs the function of an element of a combination claim in suit, does the fact that the first named element also performs an additional function remove it from the range of mechanical equivalents?

(3) Shall a decision of a Circuit Court of the United States which is contrary to every decision of the Supreme Court of the United States on the same question of law be allowed to stand?

## STATEMENT.

In the oil well industry it has long been the practice when a well becomes non-productive or clogged by "junk", as tools dropped in, or pipes, sucker rods, drills or the like broken off and unremovable, to "sidetrack" or "offset" by drilling at an angle to the original hole to make a new lower part of the well in order to by-pass the obstruction. Originally this was accomplished by blasting away the lower portion of the well casing to let the drill out.

About the year 1910 Fred I. Getty, devised a tool called a whipstock (Record p. 76), being a plain cylinder of metal about fifteen feet long tapered to near a point at its upper end (R. p. 75) which was lowered into the well, whereupon a milling cutter screwed upon a string of drill stem pipe was lowered and revolved. Wedged over against the casing by the whipstock, the milling cutter formed a "window" in the casing. Then the well drill was put in, and, also guided to the window by the whipstock, was enabled to continue drilling past the obstruction (R. ps. 78, 79).

It was at once found that revolution of the cutter against the whipstock tended to cause it to revolve in the well about an axis common to the cutter and the whipstock, which revolution defeated the attempt to produce a clean window (R. ps. 80, 81).

The practice was adopted of sanding in the whipstock with sand, fine gravel, or pounded-up pieces of metal (R. p. 83). This became and remained the universal practice for about thirteen years.

In the year 1923 Getty, petitioner here, made the invention in suit and almost immediately filed his application for the patent at bar, and the claims in suit were in substance allowed as filed since Getty was the first to conceive

a whipstock equipped with mechanical locking means to be lowered into a well with provisions to release the locking means and set the whipstock at any predetermined location in the well. This patent is therefore a pioneer patent in its field (R. p. 77).

About the year 1926, Frank Kinzbach, one of the defendants herein, filed an application for patent, disclosing substantially the structure illustrated in the appendix marked Kinzbach, and made claims of the nature alleged by him to be invalid in this suit. His claims were rejected on the Getty patent at bar and he therefore knew all about Mr. Getty's patent throughout his whipstock exploitation, from a date variously stated by defendant to be between 1926 to 1930 (R. p. 545).

Getty learned certainly of the alleged infringement in March 1939 (R. p. 530) and filed his suit on October 7, 1939 (R. p. 4).

## ERRORS TO BE URGED.

The Circuit Court erred:

1. In holding that the scope of valid broad claims of a pioneer patent, in the absence of limiting prior art, is limited to the structure disclosed by the patent for purpose of illustration;

2. In holding that the performance of an additional function by an element of an infringing structure removes it from the range of mechanical equivalents;

3. In holding that the doctrine of the *Morse Telegraph* case, that even a pioneer inventor may not monopolize all possible means for achieving the objects of the invention, applies not only to the general combination claimed but follows through each element of the combination to the final details, thereby limiting the broadest claim, by construction, to the equivalent of the narrowest claim that could be worded;

4. In holding that the claims while broad are vague.

## REASONS FOR GRANTING THE WRIT.

The Court below held that "All" (of petitioner's claims in the patent alleged as infringed) "are exceedingly vague in themselves, and literally taken are very broad" (R. p. 585), and that "The claims can be made meaningful and sufficient only by saying the means meant are those set forth in the disclosure" (R. p. 585), and that "The inventive novelty of the patent, assuming there is novelty and invention, *must lie in the means disclosed* for controlling and operating the wedge" (R. p. 585) and that "Getty's claims are in reality all combination claims. *The means they monopolize are only those disclosed.* (R. p. 586). (Italics inserted)

We believe this is bad law, contrary to every case in this Court on the issue presented.

### I.

The decision is counter to all principles of the law of patents as applying to construction of claims, which law has been built up over a century of jurisprudence, and is now accepted by the courts, text writers, and upon which the foundations of administering the Patent System by the United States Patent Office are based.

In *Smith* v. *Snow*, 294 U. S. 1, the Court held that while the patentee had detailed presumably the best way known to him of securing the objects of the invention, he was not confined to that particular mode, "*since the claims of the patent, not its specifications, measure the invention*", and that "*it is not necessary to embrace in the claims or describe in the specifications all possible forms in which the claimed principle may be reduced to practice*" (Italics inserted). Citing with approval *Paper Bag Patent* Case, 210 U. S. 405, 419.

In the *Paper Bag Patent* Case, *supra*, the Court held that the range of equivalents depends on the extent and nature of the invention. If the invention is broad and primary in its character the range of equivalents will be correspondingly broad.

In *Keystone Mfg. Co.* v. *Adams*, 151 U. S. 139, 145, the Court held that "the Courts should not be ready to adopt a narrow or astute construction, fatal to the grant."

In *Hobbs* v. *Beach*, 180 U. S. 383, 400, 401, the Court said:

> "Without determining what particular meaning, if any, should be given to these words," (substantially as described) "we are of the opinion that they are not to be construed as limiting the patentee to the exact mechanism described; but that he is still entitled to the benefit of the doctrine of equivalents, and that it is still true, as observed in Morley Sewing Machine Co. v. Lancaster, 129 U. S. 263, 273: 'Where an invention is one of a primary character, and the mechanical functions performed by the machines are, as a whole, entirely new, all subsequent machines which employ substantially the same means to accomplish the same results are infringements,' although the subsequent machine may contain improvements in the separate mechanisms may contain improvements in the separate mechanisms which go to make up the machine."

In *Clough* v. *Barker*, 106 U. S. 166, 177, 178, the Court said:

> "* * * the defendants' valve-arrangement must be held to have been an equivalent for that of Clough to the full extent to which that of Clough goes, involving, perhaps, patentable improvements, but still tributary or subject to the patent of Clough. It is true that the patent describes the tubular valve as being inside of the burner-tube. But Clough was the first person who applied a valve regulation of any kind to the combination to which he applied it, and the first person who made such a combination, and he is entitled, under decisions heretofore made by this court, to hold as infringements all valve regulations, applied to such a combination, which perform the same office in substantially the same way as, and were known equivalents for, his form of valve regulation."

## II.

In holding that the claims are exceedingly vague the Court below does not seem to have assimilated the principles of claim interpretation laid down for it by *Temco*

*Electric Co.* v. *Apco,* 275 U. S. 319, 330. In that case the Circuit Court of Appeals of the 5th Circuit held "That claim is about as vague as it could be made" while this Court in disagreeing said (p. 330) "Reading the claim with the specifications and the drawings, which are both clear * * *. It does not seem to us that the claim is vague" * * *. Vagueness goes to validity and here validity is assumed, but this attitude of the Court below undoubtedly influenced their narrow construction".

III.

The decision is against public policy. The progress of science and the useful arts is promoted by patents in proportion to the incentive they offer to invent. If all patent claims are to be so construed that they are only infringed by exact copy of the illustrative embodiment described and shown in the patent, few patents would have any substantial value and pioneer patents would have the least value as the field for the avoidance would be most broad in a field not yet explored by inventive effort.

As stated in Robinson on Patents, Vol. 1, Sec. 36:

> "The process of invention triumphs, in all civilized nations, being directly in proportion to the encouragement offered inventors by the State."

IV.

In the appendix herein there appear drawings of the Getty structure and of the Kinzbach structure complained of and between these are printed the claims divided into their elements with lead lines from each element to the part of each drawing answering thereto. Claim 3 is satisfied by the combination of a whipstock (first element) with wedging means (any kind) second element, and with means to bring said wedging means into action at will to lock the body against movement within the well casing.

The principle of construction adopted by the lower court can be carried as far as necessary to avoid infringement

in any case whatsoever. Getty discloses a frangible pin named as brass. Had Kinzbach adopted the frangible pin idea to hold his trigger block and had made his pin of wood then—not being the form disclosed by Getty—infringement would be avoided. Many forms of means to release the wedge at will could be devised and coming within the terms of the claims would infringe under a correct application of the law laid down by this Court but not under the rule here adopted by the lower Court.

## INFRINGEMENT.

In the device of the patent, referring to the drawings printed in the appendix, there is shown a whipstock body at A, a locking wedge at B, a spring at C, and a frangible pin at D.

In preparation for placing the device in a well the wedge B is pulled down to tension the spring C until the frangible pin D can be inserted. The device is lowered into the well by means of a lowering tool E.

When the bottom of the wedge B strikes upon anything in the well, the weight of the device shears the pin D and the spring C pulls up upon the wedge. The device may now be raised to any desired point, whereupon when the motion is reversed and the weight of the tool comes upon the wedging surfaces of B and its coacting surface, further downward movement is impossible, and the lock may be made rigid by pounding down with the tool E in the act of shearing off the attaching bolt. In the device of Kinzbach a sliding latch or block marked D is used instead of the frangible pin of Getty and the wedge is released by the trigger pivoted to the block striking any object upon upward movement, usually a joint in the casing, after the device has been lowered so far as desired. However it was brought out at the trial (R. ps. 335, 338) that upon upward movement of the Kinzbach structure to set at a higher point if desired, the pivoted trigger member will bend downward, it being made of slight resistance to bending for this purpose.

It will therefore be seen that the fundamental difference between these two structures is that Getty shows a device that is released for action upon downward contact with an object and Kinzbach is released for action upon upward contact with some object, that both release their wedges by such contact allowing the spring to come into action, and that both after release of the wedges may be lifted to any point where it is desired to set the whipstock and it will be set by subsequent slightly downward motion. The elements of the claims complained of are shown in boxes with lead lines from each to the element of each structure corresponding to the recitation.

At trial and at argument before the Court of Appeals, Counsel for both parties proceeded upon the assumption that the settled principles of the law of claim interpretation would be followed. Consequently the questions here presented were neither briefed nor argued before the Court of Appeals. However upon receipt of the opinion of the Court of Appeals, it was found that that Court had decided the case upon a theory of claim interpretation directly contrary to the principles laid down by this Court in the cases cited herein.

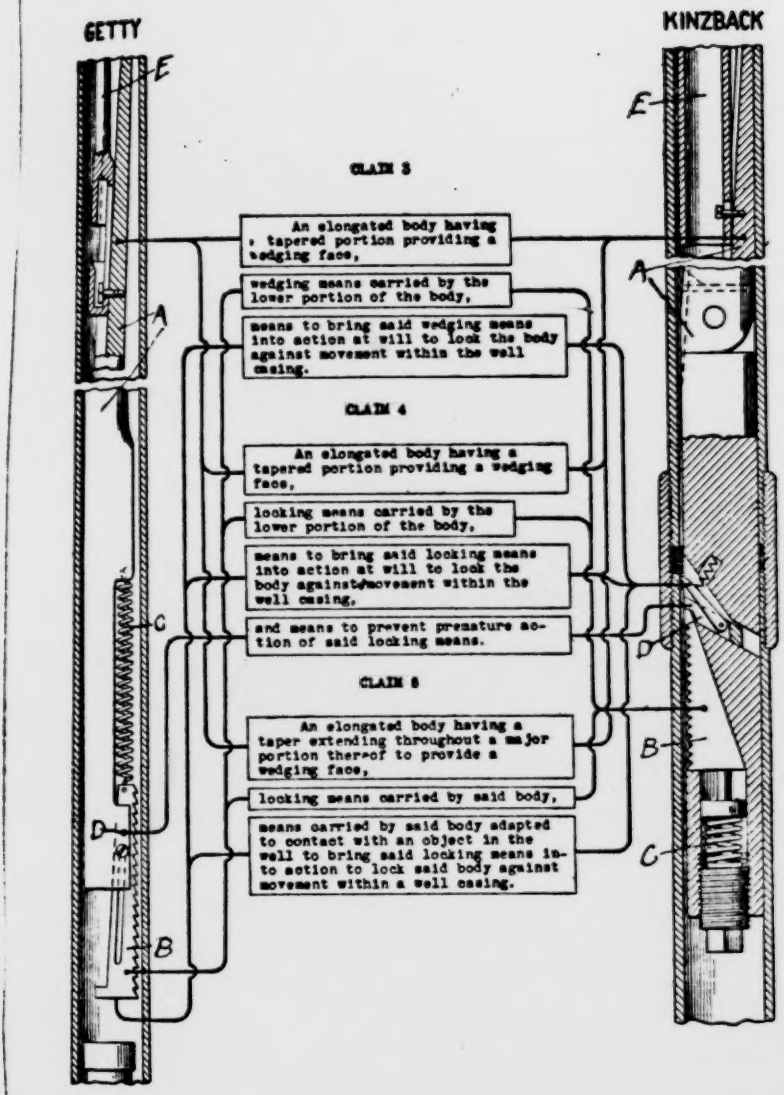
Therefore Counsel for Petitioner on May 6, 1941 filed a timely petition for reconsideration, copy of which is found in the record at page 587 calling attention to the errors of law, of which Petitioner complains herein, which petition was denied without opinion on May 10, 1941 (R. p. 590).

## CONCLUSION.

For the reasons stated it is respectfully submitted that a writ of certiorari should be granted.

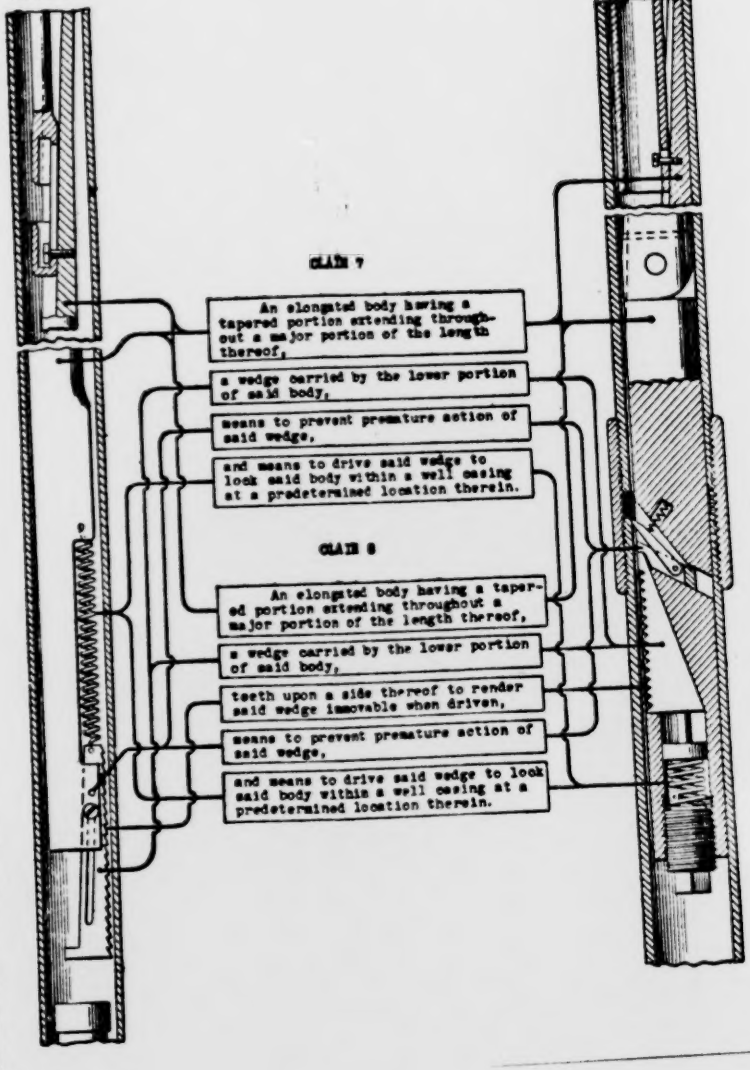
NELSON J. JEWETT,
J. O. MODISETTE,
GEORGE B. SPRINGSTON,
*Counsel for Petitioner.*

July 21, 1941.


GETTY
KINZBACK
E
A
C
D
B
CLAIM 3
An elongated body having a tapered portion providing a wedging face,
wedging means carried by the lower portion of the body,
means to bring said wedging means into action at will to lock the body against movement within the well casing.
CLAIM 4
An elongated body having a tapered portion providing a wedging face,
locking means carried by the lower portion of the body,
means to bring said locking means into action at will to lock the body against movement within the well casing,
and means to prevent premature action of said locking means.
CLAIM 8
An elongated body having a taper extending throughout a major portion thereof to provide a wedging face,
locking means carried by said body,
means carried by said body adapted to contact with an object in the well to bring said locking means into action to lock said body against movement within a well casing.

GETTY

KINZBACK



CLAIM 7

An elongated body having a tapered portion extending throughout a major portion of the length thereof,

a wedge carried by the lower portion of said body,

means to prevent premature action of said wedge,

and means to drive said wedge to lock said body within a well casing at a predetermined location therein.

CLAIM 8

An elongated body having a tapered portion extending throughout a major portion of the length thereof,

a wedge carried by the lower portion of said body,

teeth upon a side thereof to render said wedge immovable when driven,

means to prevent premature action of said wedge,

and means to drive said wedge to lock said body within a well casing at a predetermined location therein.